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Laureen E. Mauris

PATENT

8427

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TC 1700

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Applicant: Keith H. Baker et al

Serial No.: 09/785,876

Group Art Unit: 1751

Filed: February 16, 2001

Examiner: E.B. Elhilo

For: **Compositions for Pre-Treating Shoes and Methods and Articles Employing Same**

TRANSMITTAL OF APPEAL BRIEF

Attn: Board of Appeals
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Submitted herewith in triplicate is an Appeal Brief in support of the Notice of Appeal filed by Certificate of Mailing on March 31, 2003 and received by the U.S. Patent and Trademark Office on April 11, 2003. Also submitted herewith is a Second Amendment Under 37 C.F.R. 1.116. Please charge the amount of \$320.00 for payment of the government fee for filing the present Appeal Brief to our Visa credit card account. Form PTO-2038 is attached.

Please charge any additional fees required or credit any excess in fees paid in connection with the present communication to Deposit Account No. 04-1133.

Respectfully submitted,

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Dear Sir:

The present Appeal Brief is submitted in support of the Notice of Appeal filed by certificate of mailing on March 31, 2003 and received by the U.S. Patent and Trademark Office on April 11, 2003.

I. REAL PARTY IN INTEREST

The real party in interest is the assignee of the present application, The Procter & Gamble Company of Cincinnati, Ohio.

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals or interferences known to the Appellant, the Appellant's undersigned legal representative or the assignee which will directly effect or be directly effected by or having a bearing on the Board's decision in the present appeal.

III. STATUS OF THE CLAIMS

Claims 1-12 and 27-31 are pending in the present application. Claims 13 - 26 have been cancelled. Claims 1-12 and 27-31 stand rejected and are the subject of the present appeal. A complete copy of the pending claims 1-12 and 27-31 on appeal is set forth in the Appendix.

IV. STATUS OF AMENDMENT FILED SUBSEQUENT TO FINAL REJECTION

Appellants have appealed the Examiner's final rejection of the claims set forth in the Official Action dated January 2, 2003. A First Amendment under 37 C.F.R. § 1.116 was submitted by Certificate of Mailing on February 28, 2003. In an Advisory Action dated March 13, 2003, the Examiner indicated that the Amendment would not be entered on the grounds that the amendments therein do not place the application in better form for appeal.

A Second Amendment under 37 CFR § 1.116 is submitted herewith. In the Second Amendment, claims 7 and 8 are amended to correct article usage in order to put the claims in better form for appeal.

The Appendix submitted herewith does not incorporate the amendments set forth in the First Amendment under 37 C.F.R. § 1.116, but does incorporate the amendments set forth in the Second Amendment under 37 C.F.R. § 1.116. In the event that the Examiner does not enter the Second Amendment under 37 C.F.R. § 1.116, a revised Appendix will be provided.

V. SUMMARY OF THE INVENTION

The claimed invention is directed to compositions for treating shoes, especially shoes that contain canvas, nylon, mesh, synthetic leather and/or natural leather surfaces, particularly leather-containing shoes such as athletic shoes (page 4, lines 1-4).

Independent claim 1 is directed to a pre-treating composition for shoes comprising a polymeric soil release agent and a spreading agent.

Claims 2, 7, 9, 10 and 27-31 depend directly from claim 1 and further define the pre-treating compositions. Claim 2 is directed to a pre-treating composition as recited in claim 1 wherein the polymeric soil release agent is a polysaccharide. Claim 7 is directed to pre-treating compositions as recited in claim 1 wherein the spreading agent is a nonionic surfactant. The compositions defined by claim 9 further comprise an antimicrobial agent, and claim 12 further recites that the antimicrobial agent is water insoluble, and the water insoluble antimicrobial is made soluble by the addition of ethanol to an aqueous system. The compositions defined by claim 10 further comprise a drying agent, and claim 11 further defines the drying agent as comprising ethanol. Claim 27 is directed to pre-treating compositions as recited in claim 1 comprising the polymeric soil release agent in an amount effective to provide soil release benefit. Claims 28 and 29 are directed to a pre-treating compositions as recited in claim 1 comprising from about 0.1 to about 95%, and from about 0.1 to about 10% of the polymeric soil release agent, respectively. Claims 30 and 31 are directed to pre-treating compositions as recited in claim 1, comprising from about 0.1 to about 5%, and from about 1 to about 50% of the spreading agent, respectively.

Claims 3, 4 and 8 directly depend from claim 2. Claim 3 is directed to a pre-treating composition as recited in claim 2 wherein the polysaccharide is carboxymethylcellulose. Claim 4 further defines the polysaccharide of claim 2 as having a molecular weight less than about 1,000,000. Claims 5 and 6 restrict this molecular weight range to less than about 500,000, and less than about 250,000 respectively. Claim 8 is directed to pre-treating compositions as recited in claim 2 wherein the spreading agent is a nonionic surfactant.

VI. ISSUE ON APPEAL

The single issue on appeal for review by the Board is the rejection of claims 1-12 and 27-31 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,306,435 to Ishikawa.

VII. GROUPING OF THE CLAIMS

With respect to the above noted issue on appeal, Appellants concede that claims 1, 7-9, and 30-31 stand or fall together. However, Appellants submit that claims 2-6, 10-11, 12 and 27-29 are independently patentable from claim 1 from which they directly or indirectly depend. Reasons in support of the independent patentability of these claims are set forth below.

VIII. ARGUMENTS

As will be set forth in detail below, the compositions as defined by claims 1-12 and 27-31 are nonobvious over and patentably distinguishable from U.S. Patent No. 5,306,435 to Ishikawa. Accordingly, the rejection of claims 1-12 and 27-31 under 35 U.S.C. § 103(a) should be reversed. Favorable action by the Board is respectfully requested.

A. The Examiner's Position

In rejecting claims 1-12 and 27-31 under 35 U.S.C. § 103(a) as being obvious over Ishikawa, the Examiner asserts that the reference teaches a composition for treating leather such as shoes, and teaches a composition comprising ingredients such as carboxymethylcellulose (CMC) (as the polysaccharide of instant claim 2 and the polymeric soil-release agent of instant claim 1), and nonionic surfactants (as the spreading agent of instant claim 1), in amounts within the instantly claimed ranges. The Examiner contends that it would be obvious to the skilled person in the art to make such a composition for treating and cleaning shoes by optimizing the "ingredients such as CMC" in order to get the

maximum effective amount for treating and cleaning shoes. The Examiner concludes therefore, that a prima facie case of obviousness has been established.

B. Prima Facie Obviousness is not Established

Ishikawa teaches a composition for treating the raw materials from which articles such as shoes, handbags, clothing, and the like, are manufactured. The Ishikawa treatment composition comprises a water-soluble or water-dispersible polyurethane; a salt of Al, Cr or Zr, a surfactant comprising at least one nonionic surfactant which is an ethylene oxide adduct, and auxiliary ingredients including, for example, dispersants and cross-linking agents, and defined as those conventionally used in leather, fur and fibrous treating compositions (col. 3, lines 62-66). The Ishikawa composition is intended for application to leather, fur pelt or fibrous material prior to the assembly of an upstream article. It is intended for use as a sealant and shrink-proofing agent (col. 1, lines 8-9; col. 2, lines 36-49).

Appellants respectfully submit that Ishikawa fails to teach or suggest a treatment composition comprising a polymeric soil release agent as recited in instant independent claim 1. Further, Applicants submit that Ishikawa fails to teach or suggest a treatment composition comprising a polysaccharide as recited in instant claim 2. Additionally, Applicants submit that Ishikawa fails to teach or suggest a treatment composition comprising the carboxymethylcellulose (CMC) as recited in instant claim 3.

Appellants respectfully submit that the Examiner's assertion of Ishikawa disclosing carboxymethylcellulose (CMC) as an ingredient of the Ishikawa treatment solution is in error. The Ishikawa disclosure contains over 90 exemplar formulations of the treatment compositions, none of which comprise CMC. None of the Ishikawa formulations comprise a polysaccharide. Nor do any of the Ishikawa formulations comprise a polymeric soil release. In addition, none of the Ishikawa independent or dependent claims mention CMC, a polysaccharide, or a polymeric soil release agent.

The Examiner cites col. 4, line 48 of Ishikawa as supporting the Examiner's position. This portion of the specification recites use of CMC as an emulsion stabilizer. However, the Ishikawa specification at col. 4, lines 21-25 introduces the paragraphs containing the cited phrase by stating: "[t]he water-soluble and/or water-dispersible polyurethane constituting ingredient a) of the invention may be produced by any of the methods mentioned below." Clearly, the subsequent methods being disclosed are not directed to treating methods, and do not employ the Ishikawa treating compositions, but are merely means to procure the polyurethane ingredient for the treating composition. In particular, "Polyurethane 2", under which CMC is mentioned, describes a means for providing a water-dispersible polyurethane disclosed as an ingredient of some of the Ishikawa treating compositions. One of the steps involves the use of a surfactant as an emulsifier, and the use of an emulsion stabilizer. CMC is mentioned merely within the context of being one of an enumerated list of typical emulsion stabilizers known in the polymer arts. Appellants find no teaching or suggestion that an emulsifier used in polymerization of the urethane component is a suitable component in the disclosed treating composition.

Thus, Ishikawa does not contemplate CMC as an ingredient of the actual treating composition in any amount, or for any purpose. Finally, the Ishikawa specification fails to include CMC, any polysaccharide or any substance which can be identified as the polymeric soil release agent of instant claim 1, in its list of suitable auxiliary ingredients (cols. 8-9). Thus, the Ishikawa compositions do not comprise a polymeric soil release agent as required by instant claim 1. The Ishikawa compositions do not comprise a polysaccharide as required by instant claim 2. And, finally, the Ishikawa compositions do not comprise CMC as required by instant claim 3.

"To establish a prima facie case of obviousness, three basic requirements must be met. First, there must be some suggestion or motivation, either in the references themselves or in

the knowledge generally available to one of ordinary skill in the art, to modify the reference...Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP §2143. The Ishikawa reference does not teach or suggest all the limitations of the instant claims since it fails to disclose a pre-treating composition comprising a polymeric soil release agent, particularly in combination with a spreading agent. In fact, Ishikawa provides a prodigious 91 exemplar treatment compositions, none of which list a soil release agent as defined by the present specification, and none of which include CMC, or any polysaccharide as an ingredient in any amount.

Appellants also submit that the art of treating pelts and raw leather to which Ishikawa is directed does not offer an inherent motivation for combining polymeric soil release agents with spreading agents to form pre-treating compositions for shoes. Further, since Ishikawa discloses that the inventive polyurethane compositions act to swell leather, increasing its surface area by as much as 10% (column 12, lines 18-20), "a reasonable expectation of success" cannot be said to exist with respect to consumer laundering of shoes. Such swelling would be problematic with respect to shoes manufactured from leather, as seams, soles and other non-leather portions of the shoe would no longer comport with the dimensions of the leather portions.

Hence, the Examiner has failed to meet the burden of establishing a prima facie case of obviousness based on the Ishikawa reference.

The Examiner maintains that Appellants have done no more than re-hash old arguments, and have failed to provide requested secondary evidence. However, the Examiner must meet the burden of establishing a prima facie case before such secondary evidence can be required. The Examiner has repeatedly ignored or misstated Appellants' arguments with respect to the context of the Ishikawa disclosure of CMC. Appellants submit that their

arguments, though repeated, have yet to be properly rebutted by the Examiner. Hence, claims 1-12 and 27-31 are nonobvious over Ishikawa and their rejections under 35 U.S.C. § 103(a) should be withdrawn.

C. The Compositions of Claims 4-6 are Independently Patentable

Present claims 4, 5 and 6 are directed to pre-treating compositions comprising a polysaccharide, wherein the molecular weight of the polysaccharide is less than about 1,000,000, less than about 500,000, and less than about 250,000 respectively. In addition to the deficiency noted above with respect to an absence of any claimed or disclosed compositions comprising polysaccharides, Ishikawa additionally fails to disclose any molecular weight ranges. Even in the passage to which the Examiner refers as evidencing inclusion of polysaccharides, no mention is made of specific molecular weight ranges.

To establish prima facie obviousness of the claimed invention, all the claim limitations must be taught or suggested by the prior art, *In re Royka*, 490 F.2d at 981, *supra*. Ishikawa fails to teach the polysaccharide molecular weight range limitations recited in instant claims 4-6. Moreover, since the sole mention of any polysaccharide by Ishikawa is merely within the context of being an ingredient to a commonly employed polyurethane preparation method, it does not inherently suggest a molecular weight range equivalent to the presently recited polysaccharide, which behaves as the requisite soil release agent. Hence, claims 4, 5 and 6 are nonobvious over and patentably distinct from Ishikawa and the rejection under 35 U.S.C. § 103(a) should be withdrawn.

D. The Compositions of Claim 12 are Independently Patentable

Claim 12 is directed to pre-treating compositions comprising an antimicrobial agent wherein the antimicrobial agent is water insoluble and the water insoluble antimicrobial is made soluble by the addition of ethanol to an aqueous system. Antimicrobials are only generally disclosed by Ishikawa, which teaches "microbiocide" as an example of a suitable

auxiliary ingredient. While Ishikawa does discuss ethanol as an appropriate solubilizing agent, Ishikawa fails to teach or suggest water-insoluble antimicrobials, and fails to teach or suggest water-insoluble antimicrobials that are made soluble by the addition of ethanol. Not all antimicrobials are water-insoluble, and among those that are, not all are solubilized by ethanol. Hence, Appellants submit that the specific antimicrobials recited by instant claim 12 are not disclosed nor suggested by Ishikawa.

To establish *prima facie* obviousness of the claimed invention, all the claim limitations must be taught or suggested by the prior art, *In re Royka*, 490 F.2d at 981, *supra*. The broad teachings of a reference cannot preclude establishment of unobviousness for a specifically claimed invention not anticipated by the reference. *In re Orfeo*, 169 USPQ 487 (CCPA 1971). Ishikawa fails to teach or suggest the specific antimicrobials recited in instant claim 12. Hence, the pre-treating compositions of instant claim 12 are nonobvious and independently patentable over Ishikawa, and the rejection under 35 U.S.C. § 103 should be withdrawn.

E. The Compositions of Claims 27-29 are Independently Patentable

Instant Claim 27 is directed to pre-treating compositions comprising the polymeric soil release agent in an amount effective to provide soil release benefit. Claims 28 and 29 are directed to pre-treating compositions comprising from about 0.1 to about 95% and from about 0.1 to about 10% of the polymeric soil release agent, respectively. Ishikawa, on the other hand, fails to disclose, either textually or via example, compositions comprising effective amounts of any polymeric soil release agents. As explicated *supra*, the only Ishikawa disclosure of an instantly disclosed polymeric soil release agent is the brief mention of CMC in the context of its optional use as an emulsion stabilizer during the manufacture of the polyurethane ingredient. Applicants submit that it is error to construe this disclosure as a limitation that has bearing on the patentability of the instant pre-treating compositions.

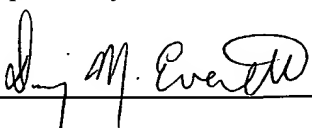
Applicants further submit that, regardless, CMC is not taught nor suggested in an amount effective to provide soil release benefit as recited in claim 27 or in amounts within the respective ranges of claims 28 and 29. Applicants further submit that the amount of CMC required to function as an emulsion stabilizer in the manufacture of polyurethanes would be irrelevant to an amount present in the inventive treatment compositions.

To establish prima facie obviousness of the claimed invention, all the claim limitations must be taught or suggested by the prior art, *In re Royka*, 490 F.2d at 981, *supra*. Furthermore, references relied upon to support a rejection under 35 U.S.C. §103 must provide an enabling disclosure, i.e., they must place the claimed invention in the possession of the public, *In re Payne*, 203 U.S.P.Q. 245 (CCPA 1979). Ishikawa fails to teach an effective amount of polymeric soil release agent, and fails to teach the instantly claimed ranges. There is nothing intrinsic to the art of treating raw leather and pelts that would inherently suggest to a person of ordinary skill in the art seeking to pre-treat shoes, what would constitute an effective amount or the instantly claimed ranges. Therefore, the Ishikawa disclosure does not enable the compositions of claims 27-29. Hence, claims 27-29 are nonobvious over and independently patentable from Ishikawa and the rejection under 35 U.S.C. § 103 should be withdrawn.

IX. CONCLUSIONS

For the reasons set forth in detail above, the compositions defined by the claims 1-12 and 27-31 are nonobvious over and patentably distinguishable from Ishikawa. Therefore, the rejection of claims 1-12 and 27-31 under 35 U.S.C. §103 should be reversed. Favorable action by the Board is respectfully requested.

Respectfully submitted,



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APPENDIX

1. A pre-treating composition for shoes comprising a polymeric soil release agent and a spreading agent.
2. A pre-treating composition according to Claim 1 wherein the polymeric soil release agent is a polysaccharide.
3. A pre-treating composition according to Claim 2 wherein the polysaccharide is carboxymethylcellulose.
4. A pre-treating composition according to Claim 2 wherein the molecular weight of the polysaccharide is less than about 1,000,000.
5. A pre-treating composition according to Claim 4 wherein the molecular weight of the polysaccharide is less than about 500,000.
6. A pre-treating composition according to Claim 5 wherein the molecular weight of the polysaccharide is less than about 250,000.
7. A pre-treating composition according to Claim 1 wherein the spreading agent is a nonionic surfactant.
8. A pre-treating composition according to Claim 2 wherein the spreading agent is a nonionic surfactant.
9. A pre-treating composition according to Claim 1 further comprising an antimicrobial agent.
10. A pre-treating composition according to Claim 1 further comprising a drying agent.

11. a pre-treating composition according to Claim 10 wherein the drying agent comprises ethanol.

12. A pre-treating composition according to Claim 9 wherein said antimicrobial agent is water insoluble, and said water insoluble antimicrobial is made soluble by the addition of the ethanol to an aqueous system.

27. A pre-treating composition according to claim 1, comprising the polymeric soil release agent in an amount effective to provide soil release benefit.

28. A pre-treating composition according to claim 1, comprising from about 0.1 to about 95% of the polymeric soil release agent.

29. A pre-treating composition according to claim 1, comprising from about 0.1 to about 10% of the polymeric soil release agent.

30. A pre-treating composition according to claim 1, comprising from about 0.1 to about 5% of the spreading agent.

31. A pre-treating composition according to claim 1, comprising from about 1 to about 50% of the spreading agent.